

396.43509X00

DR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: T. MATSUMOTO, et al.
Serial No.: 10/777,082
Filed: FEBRUARY 13, 2004
Title: INSULATED ULTRAFINE POWDER, PROCESS FOR
PRODUCING SAME AND RESIN COMPOSITE MATERIAL
WITH HIGH DIELECTRIC CONSTANT USING SAME
Group AU: 1751
Examiner: Kallambella M. Vijayakumar
Confirm. No.: 4125

RESPONSE

Mail Stop: AMEND – NO FEE

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

October 27, 2006

SIR:

In response to the Office Action mailed September 28, 2006, Applicants respectfully elect the Group I claims (that is, claims 1-5, directed to an insulated ultrafine powder), this election being made with traverse. As will be shown in the following, it is respectfully submitted that subject matter as claimed in the claims of Groups I-IV are not independent and distinct such that restriction among these groups of claims is proper.

Thus, the Group I claims are directed to an insulated ultrafine powder. The Group II claim recites a method of making this insulated ultrafine powder. Thus, as claimed, the method requires forming of the powder of claim 1. Applicants respectfully traverse the contention by the Examiner that the process of the Group II claim can be used to form a product other than that of the Group I claims. To the contrary, there is no proper basis for restriction between the Group I and Group II claims.

Moreover, the claims of Groups III and IV require the insulated ultrafine powder of claim 1. Again emphasizing that the Group II claim expressly recites the forming of the powder of claim 1, Applicants respectfully traverse the contention of the Examiner that the Groups III and IV claims, on the one hand, and the Group II claim, on the other, are unrelated. To the contrary, they are related with respect to the insulated ultrafine powder of claim 1.

As the claims of Group III and Group IV include respectively the insulated ultrafine powder of claim 1 (Group I claim) and the resin composite material of the Group III claims, it is respectfully submitted that the claims are so related that restriction therebetween is not proper.

In any event, note that Applicants have elected the Group I claims, directed to the insulated ultrafine powder. It is respectfully submitted that upon allowance of the claims directed to the powder, claims directed to methods of making this powder and claims directed to compositions including this powder would also of necessity be allowable, under the present circumstances. Accordingly, even if the restriction requirement is proper and not presently withdrawn, the Examiner is respectfully requested to reconsider withdrawal of the nonelected claims, and rejoin these nonelected claims in the present application and allow them to issue in a patent from the above-identified application, upon allowance of the Group I claims.

In view of all of the foregoing, reconsideration and withdrawal of the restriction requirement, and consideration on the merits in the above-identified application, of all claims presently therein, are respectfully requested.


In any event, in order to provide a complete response to the Office Action mailed September 28, 2006, Applicants respectfully elect the Group I claims (claims 1-5, directed to an insulated ultrafine powder), this election being made with

traverse, and respectfully request that at least the Group I claims be considered on the merits in the above-identified application in due course.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (case No. 396.43509X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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